

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:
Dettinger et al.

Serial No.: 10/664,537

Confirmation No.: 4274

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Filed: September 19, 2003

Group Art Unit: 2168

Examiner: Cheyne D. Ly

For: EXPANDING THE SCOPE OF AN ANNOTATION TO AN ENTITY LEVEL

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
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November 28, 2007
Date

/Sanjay Shenoy/
Sanjay Shenoy

REPLY BRIEF

Applicants submit this Reply Brief to the Board of Patent Appeals and Interferences in response to Examiner's Answer mailed on September 28, 2007. While Applicants' maintain each of the arguments submitted in Applicants' previously submitted Appeal Brief, Applicants make the following further arguments in light of the Examiner's Answer.

ARGUMENTS

Rejection of claims 1-4 and 20-24 under 35 U.S.C. 103(a) over *Evans* in view of *Palomo* and Rejection of claims 5 and 25-28 under 35 U.S.C. 103(a) over *Evans* in view of *Palomo*, and further in view of *Clark*.

The Applicable Standard for Establishing a Prima Facie Case of Obviousness.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143.

Further, the Federal Circuit has held that even if all of the elements of a claimed invention are found in a combination of prior art references, analysis requires "consideration of two factors:

- (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and
- (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success." *PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342 (Fed. Cir. 2007)

In this regard the Federal Circuit points out that in *KSR International Co. vs. Teleflex, Inc.*, 127 S. Ct. 1727 (2007) the Supreme Court "acknowledged the importance of identifying 'a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does' in an

obviousness determination." *Takeda Chemical Industries, Ltd. v. Alphaphram Pty, Ltd.*, 492 F.3d 1350, 1356 (Fed. Cir. 2007).

In this case, the references, alone or in combination, fail to teach at least the first and third limitations.

The Combination of Evans and Palomo Does Not Disclose All the Claim Elements.

Applicants respectfully submit that the combination of *Evans* and *Palomo* does not disclose providing an interface element allowing the first user to expand the scope of the annotation to encompass one or more data objects the first user is not authorized to view. Examiner argues that *Evans* discloses an interface element allowing the first user to expand the scope of the annotation to encompass one or more data objects in Column 7: Lines 5-39 and Column 8: Lines 19-60. Examiner specifically cites the following language in *Evans*:

"By annotating patient data, a healthcare provider, such as a physician, can acknowledge reviewing patient data, provide instructions, such as directions for additional tests and procedures or prescriptions for medication to administer to the patient, and approve recommendations for treatment by other healthcare providers." Column 7: Lines 22-28.

However, as argued in the Appeal brief, the portions of *Evans* cited and emphasized (above) by the Examiner are simply related to creating annotations and are not in any way related to expanding the scope of an existing annotation to encompass one or more data objects the first user is not authorized to view.

Examiner further asserts that Figure 5 in *Evans* is an example illustrating:

"progress notes (annotation) wherein the annotation is expanded to encompass one or more data objects such as History & Physical Examination on 9/26/91, and Discharge Summary-Addendum (expanding). The adding of annotation corresponding to the respective dates in the Progress Notes reasonably describes the argued limitation of "expand the scope of the annotation to encompass one or more data objects."" See Examiner's Answer: Page 8.

The Examiner seems to suggest that the Progress Notes tab 154 (or Progress Notes Module 144 or Progress Notes Data Structure 213) is an annotation, and that the

list of documents illustrated in window 155 of Figure 5 are data objects, wherein adding documents to the Progress notes tab constitutes expanding the scope of the Progress Notes Tab. Applicants respectfully disagree with the Examiner's reading of the Progress Notes tab 154 as an annotation. An annotation contains descriptive information about data objects. See ¶ [0004] of Specification. In other words, an annotation exists in relation to one or more data objects that it describes. The progress notes tab (or progress notes module or progress notes data structure) however, exists independently. For example, the Progress Notes tab 154 will exist even if it does not contain any documents. Therefore, the Progress Notes Tab cannot be construed as an annotation as suggested by the Examiner.

Furthermore, *Evans* does not support Examiner's interpretation of the Progress Notes as an annotation. For example, *Evans* describes annotations in the following lines:

"Similarly, to annotate patient data, the healthcare provider first selects an item to annotate by pointing and clicking on the item in a list displayed in the folder window 155. The provider then clicks on the annotate button 159 to open the item in an annotate window 170, as shown in FIG. 7. For example, the annotate window 170 of FIG. 7 displays a blood test result 172. As before, the healthcare provider annotates the blood test result document 172 using an input device, such as a keyboard, a mouse or an electronic pen. For example, the provider uses a keyboard to enter text "Out of Range" 174 and an electronic pen to circle 176 the out of range result. When done with annotations, the provider exits the form using the File Menu 178 and the point of care system 100 returns the provider to the patient chart window 150 (FIG. 5)." See Column 7: Lines 6-19.

Therefore, annotations are specifically described and illustrated in the above cited lines and figures. However, *Evans* does not describe Progress Notes as an annotation anywhere. Therefore, as argued in the Appeal Brief, Examiner's use of the term "annotation" in the rejection is inconsistent with the definition of annotations provided by the Applicants and by *Evans*.

Examiner further asserts:

"Another example, is "the viewer window 185 of FIG. 8 displays an x-ray 186. As before, the healthcare provider may annotate the x-ray 186 with comments and observations by clicking on the annotate button 187" (column 7, lines. 34-38). Figure 8, as provided below, illustrates the

expanding the scope of the annotation to encompass one or more data objects.

The left is the annotation wherein the annotation is expanded to encompass one or more data objects corresponding to the respective dates such as "Lateral Cervical" on 2/12/93, "Radiology Report" on 2/12/93. The adding of description (annotation) corresponding to the respective dates reasonably describes the argued limitation of "expand the scope of the annotation to encompass one or more data objects." See Examiner's Answer: Page 9.

Here, the Examiner seems to suggest that the documents listed in the window 184 of Figure 8 are data objects, and that adding (or editing) an annotation to an image in a viewer window 185 discloses expanding the scope of the annotation to encompass one or more data objects. Applicants respectfully submit that Figure 8 is simply directed to creating or altering an annotation associated with a particular data object (an image) as provided below:

"Lastly, as shown in FIG. 8, a healthcare provider uses the patient chart window 180 to view patient data. First, the healthcare provider selects a view item 182 by either pointing and clicking twice on the item in a list displayed in the folder window 184 or by pointing at the item in the list and pressing the view button 183. The double click opens a viewer window 185 to display the view item 182. For example, the viewer window 185 of FIG. 8 displays an x-ray 186. As before, the healthcare provider may annotate the x-ray 186 with comments and observations by clicking on the annotate button 187. The healthcare provider may likewise close the viewer window 185 by clicking on the close button 189." See Column 7: Lines 28-40.

Therefore, the description of Figure 8 in *Evans* is not directed to expanding the scope of an annotation to encompass one or more data objects.

There is no Motivation to Combine Evans and Palomo.

Applicants respectfully submit that there is no motivation or reason to combine *Evans* and *Palomo* to show "providing an interface element allowing the first user to expand the scope of the annotation to encompass one or more data objects the first user is not authorized to view." Furthermore, Applicants submit that the combination of *Evans* and *Palomo* is improper.

Examiner suggests that *Evans* discloses providing an interface element allowing the first user to expand the scope of the annotation to encompass one or more data objects. Examiner correctly notes that *Evans* does not disclose the limitation of "the first user is not authorized to view." Examiner therefore severs the limitations of this claim element and relies on *Palomo* to show "first user is not authorized to view."

Applicants respectfully submit that severance of the limitations of the claim element is improper because "the first user not authorized to view" is a critical adjective describing the "one or more data objects." By separating out the words "first user not authorized to view," the Examiner improperly renders these words meaningless to the rest of the claim. For example, while Applicants do not agree that *Evans* discloses allowing the first user to expand the scope of the annotation to encompass one or more data objects (as argued above), even if *Evans* did disclose this feature, all of Examiner's citations in *Evans* are directed to interacting with objects that a viewer is authorized to view, thereby making the citations irrelevant.

Furthermore, because the disclosure in *Evans* is directed specifically to modifying objects that a user is authorized to view, there is no reason or motivation to combine *Evans* with *Palomo*.

Therefore, for the reason stated above and the reasons stated in the Appeal Brief, Applicants submit that the claims are allowable, and request a withdrawal of the rejection.

CONCLUSION

The Examiner errs in finding that:

1. Claims 1-4 and 20-24 are unpatentable over *Evans* taken with *Palomo*.
2. Claims 5 and 25-28 are unpatentable over *Evans* taken with *Palomo*, and further in view of *Clark*.

Withdrawal of the rejections and allowance of all claims is respectfully requested.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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